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EXAMINER

LAO, LUN S

ART UNIT	PAPER NUMBER
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2643

DATE MAILED: 11/29/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/605,965

Applicant(s)

TADA, YUKIO

Examiner

Lun-See Lao

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 08 September 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 2-26 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 2-26 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Introduction***

1. This action is in response to the amendment filed on 09-02-2004 accompanying an RCE. Claims 2, 3, 5, 6, 8, 11 and 26 have been amended, and claims 2-26 are pending.

### ***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which the subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 2-7, 9-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over author admitted prior art (page 1, line 10 - page 3, line 14, fig. 4, hereafter APA) in view of Tsurumi et al (US Pat. 5,890,910).

Regarding claim 26, APA teaches (page 1, line 10 – page 3, line 6, fig. 4) a download system for downloading music data sets (music data, page 1, lines 10-14), a download apparatus comprising:

a player (portable player) including a storage medium (EEP-ROM) for storing music data (store music data) (page 1, lines 10-19), the storage medium having stored

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previously downloaded music data sets (downloaded, paragraph bridging pages 2 and 3);

a download device (PC 4) for downloading new music data sets to the storage medium (download to EEP-ROM, page 2, lines 5-9);

a reception device (table 3 with terminal) operatively coupled to the download device for receiving (fig. 4) music data sets transmitted from a source (download to EEP-ROM, page 2, lines 5-9).

APA does not teach (1) that the each music data set includes type data for identifying content characteristics of the music data set, the type data being designatable by a user, (2) a center station, which is the source of transmitted music data, (3) that at least one of the new music data sets include desired type data that is designated by the user and does not match any of the type data of the previously downloaded music data sets.

As to (1)-(2), Tsurumi teaches a download system (fig. 1), wherein a set of music data (release file including music-piece file) includes type data for identifying content characteristics of the music data set (release number) and the type data is designatable by a user (requirement transmitted from a terminal, col. 7, lines 46-52; editing at the host, col. 2, lines 52-62). Tsurumi also teaches a center station (host 1) is a source (download release files) of music data for a download device (terminal 3), wherein the music data includes type data (release file including release number). See col. 3, lines 16-42; col. 5, lines 7-18.

As to (3), Tsurumi teaches that the new music data sets include desired type data (next release number) that is designated by the user (requirement transmitted from a terminal, col. 7, lines 46-52; editing at the host, col. 2, lines 52-62; col. 5, lines 19-45). It would have been inherent/obvious that such editing at the host is performed by a user of the system. Tsurumi teaches that the new music data sets include desired type data (release number) that does not match any of the type data of the previously downloaded music data sets in that the latest release number included in a downloaded release file is the release number of the release file which is lastly downloaded from the host apparatus. In the following download, only the release file having the next release number is downloaded. (col. 5, lines 1-18; col. 7, line 56 – col. 8, line 6). In other words, the next release number of Tsurumi represents the type data (release number) that does not match any of the type data of the previously downloaded music data sets.

Therefore, it would have been obvious to use type data with the music data of APA and to include into the system of APA a center station that transmits music data having type data to the download device. It would also have been obvious that at least one of the new music data sets include desired type data that is designated by the user and does not match any of the type data of the previously downloaded music data sets in APA. One of ordinary skill in the art would have been motivated to combine the teachings of APA and Tsurumi because this would have sped up the downloading process by storing/saving only necessary/timely information (Tsurumi, col. 5, lines 7-18), which is desirable in APA (APA, page 3, lines 4-7).

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Regarding claim 2, APA does not teach input device, data memory device and control device.

Tsurumi teaches the downloading system including  
an input device to which type data of desired music data sets required by the user is input by the user (editing capability at the host to edit necessary information list, col. 5, lines 50-52);

a data memory device (storing unit 11) that stores the music data sets transmitted from the center station (col. 6, lines 47-50); and

a control device (control unit 10) for selecting at least one of the music data sets from the central station and storing in the data memory device (store release file in storing area 11 as specified by the necessary information file, col. 6, lines 43-59).

Therefore, it would have been obvious to include the input device, the data memory device and the control device into the system of APA as modified. Note discussion of claim 1 for a motivation to combine.

Regarding claim 3, APA as modified teaches (Tsurumi) the control device comprises:

a known type data read-in device (terminal, including means for editing) that reads in, as known type data, the type data of the music data sets previously downloaded and stored in the storage medium the player (release number of the release file lastly downloaded, col. 5, lines 1-18);

a desired type read-in device (terminal) that reads in, as desired type data (release number), the type data input by the user using the input device (requirement

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transmitted from a terminal, col. 7, lines 46-52; editing at the host, col. 2, lines 52-62; col. 5, lines 19-45). It would have been inherent/obvious that such editing at the host is performed by a user (person or program) of the system.

a new type data read-in device (communication control unit 12, control unit 10) that reads in, as new type data, the type data of the new music data sets received (downloaded release file) by the reception device (currently downloaded, col. 8, lines 1-6);

a determination device (control unit 10) that determines for each new data sets whether the new type data is equal to desired and different from all known type data (col. 6, lines 35-59; col. 7, line 52 – col. 8, line 6; fig. 4);

a data storing device (storing unit 11) for storing (store) the new music data sets transmitted from the center station in the data memory device when the new type data is equal to desired and different from all known type data (col. 6, lines 1-59; col. 7, line 52 – col. 8, line 6);

a downloading device (communication control unit 12) that downloads the music data stored in the data memory device by the data storage device to the storage medium of the portable player; and

a type data rewrite device (storing unit 11, control unit 10) that rewrites the new type data as known type data (update information, write newly released files to storage area, col. 6, lines 52-59). Note discussion of claim 1 for a motivation to combine.

Regarding claim 4, APA teaches the storage medium of the player comprises a writable ROM (EEP-ROM), and wherein the download device includes an encoding

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device that encodes music data into MPEG codes (MPEG encoder). See page 2, lines 5-10, 20-27.

Regarding claim 5, it is a method claim of claim 3 and thus note claim 3 for discussion.

Regarding claim 6, it is a program product claim of claim 5, and thus note claim 5 for discussion.

Regarding claims 7, 10, 12, APA teaches the player is a portable player (portable player, page 1, line 11).

Regarding claim 9, APA as modified teaches (Tsurumi) the download device comprises a receptor (communication control unit 12) which the player is coupled when music data is downloaded to the player.

Regarding claims 11, 13, APA teaches the player is placed on a table (table) when music data is downloaded to the player (page 1, line 27 – page 2, line 9). APA does not teach type data of music data stored in the storage medium provided in the player is read as known type data when the player is placed on the table. Tsurumi teaches type data of music data stored in the storage medium provided in the player is read as known type data (release number of the release file lastly downloaded, col. 5, lines 1-18). Therefore, it would have been obvious to read type data of music data stored in the storage medium provided in the player as known type data in APA. Note discussion of claim 1 of a motivation to combine. When the teachings are combined, it would have been obvious that such reading is performed when the player is placed on



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the table because this would have been the configuration that allows data I/O between the computer and the player.

Regarding claim 14, APA as modified teaches the type data is at least one of genre data, singer data and number data (Tsurumi, release number, col. 5, lines 7-18).

Regarding claim 15, APA teaches a recording apparatus comprising:

a player (portable player) carrying a storage medium (EEP-ROM) that stores sound data (store music data) (page 1, lines 10-19);

a recording device (PC 4) that records the sound data to the storage medium carried by the player (download to EEP-ROM, page 2, lines 5-9).

APA does not teach the sound data having type data which is capable of being designated by a user, reception device that receives the type data transmitted from a source, nor recording is performed when the type data transmitted from the source matches the type data designated by the user and the sound data has not been recorded in the recording device.

Tsurumi teaches recording apparatus, wherein sound data (release file) has type data (release number) which is capable of being designated by a user (requirement transmitted from a terminal, col. 7, lines 46-52; editing at the host, col. 2, lines 52-62; col. 5, lines 19-45). It would have been inherent/obvious that such editing at the host is performed by a user of the system. Tsurumi teaches reception device (communication control unit 12) that receives the type data (release number) transmitted from a source (host) (col. 5, lines 1-52) and recording is performed when the type data transmitted from the source matches the type data designated by the user (release file having next

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or succeeding release number) and the sound data has not been recorded (not yet transmitted) (col. 6, lines 35-59).

Therefore, it would have been obvious to include type data, reception device into the system of APA, and to record when the type data transmitted from the source matches the type data designated by the user and the sound data has not been recorded. One of ordinary skill in the art would have been motivated to combine the teachings of APA and Tsurumi because this would have sped up the downloading process by storing/saving only necessary/timely information (col. 5, lines 7-18), which is desirable in APA (APA, page 3, lines 4-7).

Regarding claim 16, APA as modified teaches the type data is at least one of genre data, singer data and number data (Tsurumi, release number, col. 5, lines 7-18).

Regarding claim 17, APA teaches music data (music data, page 1, lines 11-19).

Regarding claim 18, APA as modified teaches the center station (host 1) transmits the new music data sets to the download device (terminal 3) (Tsurumi, fig. 1).

Regarding claim 19, APA teaches the player is an MP3 player (MP3 player, page 1, lines 11-19).

Regarding claim 20, APA as modified teaches (Tsurumi) the type data transmitted from the source is stored as new type data (update information, write newly released files to storage area, col. 6, lines 52-59) and is compared with the type data designated by the user (col. 7, line 49 – col. 8, line 6; col. 6, lines 52-59).

Regarding claim 21, APA as modified teaches (Tsurumi) teaches the type data transmitted from the source is stored as known type data (latest release number, col. 7, lines 25-26; col. 7, line 49 – col. 8, line 6).

Regarding claim 22, APA as modified teaches (Tsurumi) the sound data is recorded when the new type data (next release number) is identical to the type data designated by the user (release file having next release number and not yet transmitted) and the new data is different from the known type data (latest release number at terminal) (col. 6, lines 1-59).

Regarding claim 23, APA teaches an MPEG encoder and the sound data is encoded by the MPEG encoder (MPEG encoder, page 2, lines 5-10, 20-27).

Regarding claim 24, APA teaches the recording device includes a hard disk drive (HDD 9).

Regarding claim 25, APA teaches the sound data transmitted from the source is recorded in the hard disk drive and transferred to the storage medium (store in HDD and then download to ROM of player, page 2, lines 31-35).

4. Claims 8 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over author admitted prior art (page 1, line 10 - page 3, line 14, fig. 4, hereafter APA) in view of Tsurumi et al (US Pat. 5,890,910) as applied to claim 15 and further in view of Kim et al (U S Pat. 6,083,009).

Regarding claim 18, APA as modified does not teach the reception device is a tuner and the sound data is received through the tuner.

Kim teaches a recording apparatus (fig. 2), wherein a center station is a radio station (204, transmits radio data), and a reception device is a tuner (208a, 208e, 202) through which the music data sets are received (col. 5, lines 9-62).

Therefore, it would have been obvious to include and a tuner into the system of APA as modified. One of ordinary skill in the art would have been motivated to combine the teachings of APA as modified by Tsurumi with Kim because this would have allowed a user to listen to music in the fields (col. 2, lines 23-44).

### ***Response to Arguments***

5. Applicant's arguments filed 9-2-2004 have been fully considered but they are not persuasive.

Applicant argued that "[c]ontrary to the Examiner's contentions, Tsurumi does not teach or suggest designating specific music data based on type data (again, such as title, performer, genre, etc.) and downloading such music data from a central server if such music data is not already stored in the portable player. Rather, Tsurumi only discloses periodic updating of the terminal apparatuses with the latest release updates without any regards to user selection of specific music data or type data associated with the music data (see Col. 7, lines 46-52)." (Remarks, paragraph bridging pages 11 and 12).

The examiner's response is as follows. First, while it might have been disclosed, the type data being title, performer or genre is not claimed. See each of the pending independent claims (26, 5, 6, and 15). The independent claims only require 'type data

for identifying content characteristics of the music data set'. The release number of Tsurumi identifies the release characteristics of a corresponding music data set, thus meeting the type data as claimed. During examination, applicant's claimed limitations are interpreted in light of the specification, but the specification is not read into the claims. If applicant regards the type data being title, performer and genre as the feature defining over the prior art, it needs to be brought out in the claims.

Second, to the contrary of applicant's characterization, Tsurumi teaches type data (release number) associated with music data (release file including music-piece file, col. 3, lines 16-42). Tsurumi uses such type data to determine whether the music data is already stored in the player memory because the latest release number at a terminal indicates the version of the music data already stored. Further, in Tsurumi, the music data desired by a user is represented by the release file having a next or succeeding release number (col. 5, lines 1-33; col. 6, lines 35-59). Tsurumi teaches user selection / designation / input of such type data in that the type data (release number) is provided by the requirement transmitted from a terminal (col. 7, lines 46-52) and/or the editing, at the host, of the release file information (col. 2, lines 52-62; col. 5, lines 19-45; col. 7, lines 46-52). One of ordinary skill in the art would recognize that file editing is typically performed by a user (person or program) of the system. Note discussion of Tsurumi with respect to claims 26 and 3 for details.

Applicant further argued that "Kim makes no mention of designating music data by using associated type data." (Remarks, page 12, 3<sup>rd</sup> paragraph).

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The examiner's response is that Kim is not relied on to teach designating music data with associated type data, which is met by the combination of APA and Tsurumi, as discussed in detail in the rejection of claim 26, 3 and 15 and the response above.

**Conclusion**

6. Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

Washington, D.C. 20231

or faxed to: (703) 872-9306


Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA., Sixth Floor (Receptionist).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lao, Lun-See whose telephone number is (703) 305-2259. The examiner can normally be reached on Monday-Friday from 8:00 to 6:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Curtis Kuntz, can be reached on (703) 305-4708.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Technology Center 2600 whose telephone number is (703) 306-0377.

Lao, Lun-See  
Patent Examiner  
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DUC NGUYEN  
PRIMARY EXAMINER